

REMARKS

Status of the claims:

With the above amendments, claims 1-4, 6-32, 36, 37, 39, and 63-81 are pending and ready for further action on the merits.

Claims 1, 10, 12-15, 20, 21, 24 and 27-29 have been amended.

Claims 5, 33-35, 38, and 40-62 have been canceled.

New claims 63-81 have been added.

No new matter has been added by way of the above amendments. Support for the amendment to claim 1 can be found in original claim 10 among other places. All other changes are merely editorial in nature or are made to comply with the Examiner's restriction requirement. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. §112, second paragraph

Claims 1-45 are rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite.

The Examiner asserts that the claims are not in the correct Markush language format. Applicants have amended the claims so that they are now in correct Markush language or other correct format. It is believed that with these amendments that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner also asserts that there are two different definitions for X and Y (in claim 1). Applicants have corrected the claims so that there are no longer two definitions for X and Y (*i.e.*, X has been replaced by X₂ and Y has been replaced by Y₂). Applicants believe that with this amendment the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner further asserts that claim 21 is missing the word "and". Applicants have amended claim 21 to address this rejection. Applicants believe that with this

amendment the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. §112, first paragraph

Claims 30, 33-35, 38 and 40-45 are rejected under 35 U.S.C. §112, first paragraph as allegedly not being enabled.

Applicants traverse.

While Applicants disagree with the Examiner's basis for rejecting claims 33-35, 38, and 40-45 under §112, first paragraph as allegedly not being enabled, in the interest of expediting allowance of this application, Applicants have canceled claims 33-35, 38, and 40-45 so the rejection is moot with respect to those claims. Applicants reserve the right to submit these claims in a separate application.

Regarding claim 30, Applicants disagree that a composition cannot be made and used without undue experimentation that contains one or more of alkylating agents, antimetabolites, plant alkaloids, antibiotics, hormones, biologic response modifiers, analgesics, NSAIDs, DMARDs, glucocorticoids, sulfonylureas, biguanides, acarbose, PPAR agonists, DPP-IV inhibitors, GK activators, insulin, insulin mimetics, insulin secretagogues, insulin sensitizers, GLP-1, GLP-1 mimetics, cholinesterase inhibitors, antipsychotics, antidepressants, anticonvulsants, HMG CoA reductase inhibitors, cholestyramine, or fibrates. Examples of these compounds are listed in paragraphs [1181] to [1207]. Applicants submit that the components enumerated in these paragraphs could easily be added to the compounds of the present invention to make a composition that can be made and used without undue experimentation.

For the above reasons, Applicants submit that the enablement rejection is inapposite.

Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1-3, 5-10, 12, 13, 16, 18, 20 and 22-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Thurieu '140 (WO 2002/10140), Mjalli '140 (WO 2002/10140), Mjalli '487 (WO 2000/23487), Gordon '942 (WO 99/65942), Thurieu '401 (WO 99/64401), and Yatabe '714 (CA 129:95714, 1998). Applicants traverse.

Applicants have amended claim 1 so that none of the compounds disclosed in the cited references fit within the scope of any of the claims. In particular, Ar₁ and its substituents have been amended so that none of the enumerated compounds from the cited references fit within the scope of the claims. Accordingly, an anticipation rejection is inapposite.

Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-3 and 5-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thurieu '140 and Thurieu '401. Applicants traverse.

Applicants submit that there is very little overlap, if any, between the genera disclosed in the present invention and either of the genera disclosed in Thurieu '140 and/or Thurieu '401. Applicants have amended independent claim 1 so that there are no disclosed compounds that fit within the scope of the claimed genus in the present invention. Moreover, Applicants respectfully draw the Examiner's attention to *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) wherein the Federal Circuit found that when a genus is sufficiently large, one can not select specific moieties from a genus to render a smaller genus obvious. In effect, Applicants submit that this is what the Examiner is doing in this rejection. Accordingly, as a matter of law, the very large genera disclosed in Thurieu '140 and Thurieu '401 cannot render *prima facie* obvious the presently claimed genus. The rejection is inapposite.

Withdrawal of the rejection is warranted and respectfully requested.

FEES

This response is being filed within 4 months of the Office Action mailed January 26, 2007, which set a shortened statutory period of three months for a reply. As a result, a one month extension fee is due.

Applicants previously paid for 62 claims and for 3 independent claims. Upon entry of these amendments, the total number of claims is 53, and the total number of independent claims is 1. Thus, no additional claim fee is necessary.

Applicants believe that no additional fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

CONCLUSION

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

Date: May 14, 2007

Ben Schroeder

T. Benjamin Schroeder (Reg. No. 50,990)

KILPATRICK STOCKTON LLP
1001 West Fourth Street
Winston-Salem, North Carolina 27101-2400
Phone: (336) 607-7486
Facsimile: (336) 607-7500